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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,500	04/16/2004	Sharon Mary Simpson	87067JLT	2197

7590

06/28/2005

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EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/826,500

Applicant(s)

SIMPSON ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 05062004/04162004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This first office action is responsive to the filing of this instance application; claims 1-25 are pending in this instant application.

2. The disclosure is objected to because of the following informalities: the citation numbers of the copending application on pages 18, lines 23 and page 70, line 6 are missing.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Simpson et al (US Patent No. 6,440,649), Chenot et al (US Patent No. 3,431,215) and Gillilan et al, "ElectroChemical Technology", Vo (4/8): pp 378-383).

Simpson et al discloses a photothermographic material substantially as claimed. See columns 47-50, except failing to disclose the use of X-radiation sensitive phosphors each of which emits in the range of from about 100 nm to 410 nm, and said X radiation sensitive phosphor comprising a rare earth phosphate, a Yttrium phosphate, a strontium phosphate, or a strontium fluoroborate claimed in the present claimed invention. Simpson et al disclose "a phosphor" that emits the radiation in the ultraviolet, visible or infrared region of the spectrum in column 9, lines 19-27; the UV-sensitive material in example 2, columns 36-39, Examples 5 in column 44. See also the additives for the photothermographic material such as chemical sensitizer in column 13,

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lines 4-25; the non-photosensitive of reducible silver ion such as silver behenate and silver salt of a compound containing an imino group such as silver salt of benzotriazole in column 14, lines 40-45 and column 15, lines 36-45; reducing agents such as ascorbic acid and hindered phenol in column 19, lines 15-67. Simpson et al may not disclose X-radiation sensitive phosphors each of which emits in the range of from about 100 nm to 410 nm, and said X radiation sensitive phosphor comprising a rare earth phosphate, a Yttrium phosphate, a strontium phosphate, or a strontium fluoroborate claimed in the present claimed invention, but the phosphor that emits the radiation in the UV has been known in Chenot et al and Gilliam et al. See Chenot in column 1 which discloses the europium activated strontium fluoroborate phosphor which emits the near uv light and extending into far uv light and Gialliam et al which discloses a list of uv emitting phosphor. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the a phosphor that emits the ration in the near uv to the near uv light and extending into far uv light taught in Chenot and Gilliland such as suggested in Simpson et al to increase the processing speed of the material of Simpson et al, and thereby provide a material and process as claimed.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/826,780. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope the term optionally, an X-radiation sensitive phosphor encompasses the phosphor claimed in the present claimed invention. See the phosphor in claims 4-5, 7-8 are the same as the phosphor claimed in claim 4-8 claimed in the present claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references provided with the information disclosure statement submitted on April 16, 2004 and May 6, 2004 have been considered and made of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *TM*  
June 23, 2005

*Thorl Chea*  
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Primary Examiner  
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